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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

ZACHARIA, RAMSEY E

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 12/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/897,014

Applicant(s)

SAIKI ET AL.

Examiner

Ramsey Zacharia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 4-15 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 16-25 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 4-15 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.
2. Applicant's election of Group I, claims 1-3, 16-25, and 27, in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The applicants' request for rejoinder of the claims of Group II in the event that the claims of Group I are found allowable has been noted.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "T1", "T2", and "T3" have been used to designate both times in Figure 5 and thicknesses in Figures 8, 9, and 12. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "1" (first mentioned on page 15, line 2), and "86" (page 17, line 23). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "90" and "127" in Figure 4, "c" in Figure 13, and "T4" and "t4" in Figure 14. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to because the phrase "GUID PIN" in Figure 3 appears to be a typographical error that should read "GUIDE PIN". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 21-25 and 27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. The phrase "said mounting portion is made of a skin layer resin material" at the end of independent claim 21 renders the claim indefinite because it is unclear whether this material is the same as that of the skin layer of the resin molded product or merely a material that may be used as a skin layer.

12. Claim 25 recites the limitation "said connecting portion" in line 2. There is insufficient antecedent basis for this limitation in the claim. Note that claim 25 depends from claim 21 while the connecting portion is first introduced in claim 22.

13. Claim 25 is rendered indefinite because the claim requires the thickness of the connecting portion to be smaller than that of a board but no dimensions or guidance as to the size of the board are given. The meaning of this limitation is unclear since, presumably, the board can be always be selected such that it is larger than that of the connecting portion.

14. Claim 27 recites the limitation "said board" in lines 3 and 4-5 and "said connecting portion" in lines 2 and 3-4. There is insufficient antecedent basis for these limitations in the claim. Note that claim 27 depends from claim 21 while the board is first introduced in claim 25 and the connecting portion is first introduced in claim 22.

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15. Claim 27 is rendered indefinite because the claim requires the thickness of the connecting portion to be larger than that of a board and the height of the connecting portion to be larger than the thickness of the board, but no dimensions or guidance as to the size of the board are given. The meaning of this limitation is unclear since, presumably, the board can be always be selected such that it is smaller than that of the connecting portion.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1, 2, 16, 18, 21, 22, 24, 25, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Madonia et al. (U.S. Patent 4,546,022) as evidenced by Hatzikelis et al. (U.S. Patent 4,493,806).

Madonia et al. teach a decorative molding that may be used on automobile parts (column 1, lines 8-11). This reads on both an external part and a housing part since the molding is applied to the exterior of the automobile which is both an external part and a housing part. The molding comprises an interior made from recycled plastic and an outer layer having a thickness of up to 12 mils, i.e. about 0.305 mm (column 1, lines 19-41). The recycled plastic of the interior is obtained using the process of Hatzikelis et al., which involves pulverizing the scrap plastic (see Madonia et al., column 2, lines 8-14; and Hatzikelis et al. column 1, lines 5-17). The

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outer skin layer is pigmented (claim 4). The decorative molding is mounted by means of adhesive layers (column 2, lines 52-54).

Regarding claim 21, the adhesive material is taken to read on the "skin layer resin material" on the last line of the claim since the adhesive material is applied on the exterior of the interior layer, and therefore is a skin layer.

Regarding claim 22, the adhesive material is taken to have elasticity since all polymers have some degree of elasticity and the claim does not require a minimum amount of elasticity.

Regarding claims 25, since this claim does not recite any particulars as to the board used, the board used is taken to be selected such that the limitations of this claim are met.

Regarding claim 26, since this claim does not recite any particulars as to the board used, the board used is taken to be selected such that the limitations of this claim are met.

### ***Claim Rejections - 35 USC § 102 / 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Madonia et al. (U.S. Patent 4,546,022) as evidenced by Hatzikelis et al. (U.S. Patent 4,493,806).

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Madonia et al. teach all the limitations of claim 3, as outlined above, except for requiring that the pulverized recycled plastic come from an external part, a housing part, or a constituent part of an office apparatus.

However, this is taken to be a product-by-process limitation, i.e. the process being pulverizing an external part, a housing part, or a constituent part of an office apparatus as opposed to the product which is just pulverized plastic. When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and MPEP § 2113. In this case, the product of Madonia et al. appears to be the same as that of the instant invention regardless of what shape the recycled plastic was in prior to its pulverization.



***Claim Rejections - 35 USC § 103***

20. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madonia et al. (U.S. Patent 4,546,022) as evidenced by Jenkins et al. (U.S. Patent 4,448,608) and Perman et al. (U.S. Patent 5,508,060).

Madonia et al. teach all the limitations of claims 19 and 20, as outlined above, except for disclosing the lightness of the outer layer.

However, the lightness L of a molded polymer composition is a function of the color of the composition (see Tables 2 and 3 of Jenkins et al.; and column 14, lines 14-28 of Perman et al.) with  $L \rightarrow 100$  as the color approaches white and  $L \rightarrow 0$  as the color approaches black.

Madonia et al. teach the addition of a pigment to the skin layer (claim 4) but are silent as to the color of the pigment.

The examiner takes the position that it would have been obvious to one of ordinary skill in the art to use any pigment, including white pigments, depending on the desired color of the finished product.

Therefore, the inventions of claims 19 and 20 would have been obvious to one of ordinary skill in the art at the time the inventions were made.

21. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koch (U.S. Patent 4,023,896) in view of Madonia et al. (U.S. Patent 4,546,022).

Koch is directed to a photocopy machine (column 1, lines 60-68). The photocopy machine comprises a decorative machine housing (column 2, lines 37-43).

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While Koch discloses that the photocopier machine housing is decorative in nature, the reference is silent as to the nature of the decoration.

Madonia et al. teach a decorative molding (column 1, lines 8-11) that may also be used as a protective molding (column 1, line 64-column 2, line 1). The molding comprises an interior made from recycled plastic and an outer layer having a thickness of up to 12 mils, i.e. about 0.305 mm (column 1, lines 19-41). This thickness should be enough to suppress the transmission of color from the core layer since the instant application specifically cites a thickness of 0.3 mm as being suitably thick.

One of ordinary skill in the art would be motivated to use the decorative molding of Madonia et al. as a decoration on the decorative housing of Koch because the molding offers protection to the housing in addition to its decorative value.

Therefore, the invention of claim 17 would have been obvious to one of ordinary skill in the art at the time the invention was made.

22. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Madonia et al. (U.S. Patent 4,546,022) in view of Vaughan et al. (U.S. Patent 5,702,148).

Madonia et al. teach all the limitations of claim 23, as outlined above, except for the use of a screw connecting portion as the mounting portion. Madonia et al. do teach that an adhesive may be used to mount the decorative article (column 2, lines 52-54).

Vaughan et al. is directed to a decorative molding used in automobiles (column 2, lines 33-44). The molding may be mounted by means of an adhesive or a screw (column 7, lines 40-46).

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Vaughan et al. show that adhesive and screws are known in the art as equivalent attaching means for decorative moldings in the automotive industry. Therefore, because these two means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute screw mounts for the adhesive strips.

Therefore, the invention of claim 23 would have been obvious to one of ordinary skill in the art at the time the invention was made.

### *Conclusion*

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (703) 305-0503. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for non after-final correspondences and (703) 872-9311 for after-final correspondences.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ramsey Zacharia

Patent Examiner

Technology Center 1700

12/17/02